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EXAMINER

MCCORMICK, SUSAN B

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 10

Application Number: 09/754,755

Filing Date: January 04, 2001

Appellant(s): ELSNER, WILHELM

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Julie Meder  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 10, 2003.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences which will directly affect or be

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

~~The appellant's statement of the issues in the brief is correct.~~

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**(7) *Grouping of Claims***

There is only a single claim.

**(8) *ClaimsAppealed***

There is only a single claim and that claim is appealed.

**(9) *Prior Art of Record***

The following is a list of the prior art of record relied upon in the rejection of claims under appeal.

(1) UPOV-ROM GTITM Computer Database, GTI Jouve Retrieval Software, citation QZ PBR 981017 for 'Tikvio.' application publication date October 15, 1998. (A copy of the translation is enclosed for the plant 'Tikvio').

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by European Community Plant Breeder's Rights Application No. 98/1017 (published October 15, 1998) in view of Appellant's admission that 'Tikvio' was first offered for sale in Europe in October 1998.<sup>1</sup> The Application requires information pertaining to any prior sale. This document is open to public inspection. This is also evidenced in the UPOV-ROM GTITM Computer Database citation under the heading "DATE PUBL., APPL. FILING". Additionally, the Appellant, Breeder, and Assignee are all listed on this publication. As a result, one of ordinary skill in the art would have known whom to contact to purchase the plant. A UPOV 'hit', QZ PBR 98/1017, application publication date October 15, 1998, to a geranium plant 'Tikvio' was found. This date is more than one year prior to the filing date of the instant U.S. application. The published application is a "printed publication" under 35 U.S.C. 102 because it is

accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. In the European Community, every two months the Community Plant Variety Office publishes an Official Gazette containing all the information appearing in its Registers, such as applications for protection, proposals for variety denomination and grants of title. Other information the CPVO feels important to the public may also be published in the Gazette. For example, for Plant Breeder's Right (PBR) certificates, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination.

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Applicant, Breeder, and Assignee. This information is available on-line as well as in CD-Rom format as of the date listed that the application/filing was published which in this case was October 15, 1998 and is more than one year prior to filing of the patent application in the United States. Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. Appellant has admitted that the claimed plant was for sale more than one year prior to application for U.S. patent and thus was in the public domain. As a result, one of ordinary skill in the art could have bought the plant and asexually propagated it, thus reproducing the invention.

**(II) Response to Argument**

**Appellant argues** (page 3 of Appeal Brief) that an anticipation rejection cannot be built from multiple references. Additionally, **Appellant argues** (page 4 of Appeal Brief) that the PBR application does not disclose every material element of the claim and the rejection attempts to circumvent 35 U.S.C. § 102(b) by relying on sale outside of the U.S. more than one year prior to filing patent application in the United States, that application of *In re Samour*, 571 F.2d 559, 197 USPQ1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985) is incorrect and not supported by case law and that neither case stands for the proposition that an additional reference may be used to supplement a non-enabling disclosure of a primary reference.

**Appellant further argues** (page 10 of Appeal Brief) that *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) and *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) are consistent with *Samour*, *Donohue*, and *Bristol-Myers* and do not support a proposition that a non-enabling publication about a plant may be made enabling by public use or sale of the plant itself. Finally, **Appellant argues** (page 21 of Appeal Brief) that enablement of a PBR publication as a prior art reference is inconsistent with past and current examination practices in plant patent applications.

The Examiner generally agrees with the Appellant as to the interpretation of *In re Samour* and *In re Donohue*, however the Examiner would like to point out that the admission of Appellant that the plant was for sale more than one year prior to application for U.S. patent is not “supplementing” the primary reference, rather the sale of the plant provides proof that the primary reference was enabling. The Examiner would like to point out how the two cited cases support the rejection that was made under 102(b). As noted in *In re Samour*,

“a printed publication which discloses every material element of the claimed subject matter, would constitute a bar under 35 USC 102(b) to appellant's right to a patent if, more than one year prior to appellant's filing date, it placed [the claimed subject matter] ‘in possession of the public.’ Whether claimed subject matter was in possession of the public depends on whether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art.” 197 USPQ at 3-4 (citations omitted).

The court noted that a printed publication that places the invention in possession of the public would constitute a bar under 35 USC 102(b). This language is also used in *LeGrice* as is discussed in further detail below. A printed publication identifying the breeder and assignee of a particular plant in combination with the public availability of the plant places the plant in the public possession. On page 3, paragraph 4 of the Brief, Appellant admits that the invention was “in the possession of the public”.

The court further noted that the disclosure in the primary reference must be considered together

of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the art. 197 USPQ at 4.

As noted by Appellant, *In re Donohue* stands for the propositions that disclosure of a claimed invention in a printed publication will not suffice as prior art if it is not enabling, and that prior art under 35 USC 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." 226 USPQ at 621.

The Examiner understands that the primary contention of the Appellant is that not every material element is disclosed in the primary reference. However, here, as in *Donohue*, the invention described in the primary reference is identical to the claimed invention. If the reference teaches the invention but does not teach every single **inherent** property of the invention, it still anticipates the claim. As explained in *Donohue*:

"Appellant also argues that the references fail to teach the solubility characteristics and melting point range set forth in dependent claims 25 and 28, respectively. However, where as here, the dicarboxylic acid TMBP and dimethyl ester TMBP of Nomura are identical to the claimed invention, the properties of Nomura's compounds are inherently the same as those of the claimed invention in the absence of proof to the contrary. See *In re Best*, 562 F.2d 1252, 195 USPQ 430, 433-34 (CCPA 1977)." 226 USPQ at 622.

The claim in a plant patent application is drawn to a "plant" as described and illustrated in the specification, i.e., the claim is drawn to a plant with certain inherent characteristics. The cited Plant Breeders' Rights (PBR) document which serves as the anticipatory reference is drawn to the exact same plant as claimed. As a result, the PBR publication teaches each material element of the claim even if the disclosure is not as detailed as an application for plant patent.

As a result, contrary to Appellant's assertions, *In re Samour* and *In re Donohue* support the rejection under 35 USC 102(b). The primary reference teaches every material element of the instant invention. Appellant has not pointed out how their admission that the plant was for sale constitutes a "secondary reference." The admission of sale is used to show that the PBR publication was enabling. Even if this admission were to constitute a secondary reference, Appellant has not pointed out any "additional disclosure" it contains that is not part of the primary reference. The only reliance on the "secondary reference" (Appellant's admission that the claimed subject matter was sold [paper no. 3, page 2 of reply filed] more than one year prior to the U.S. filing date) was to show that the claimed subject matter was in the public possession more than one year prior to the filing date of the patent application.

Bristol-Myers Squibb Co.v. Ben Venue Laboratories, Inc. et al., 246 F.3rd 1368, 58 USPQ2d 1508 (Fed. Cir. 2001) as presented by the Appellant, does not have any additional bearing on this case as it concurs with both *In re Samour* and *In re Donohue*.

The Examiner notes and agrees with Appellant's statements that *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962) and *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. Pat. App. & Inter. 1992) are consistent with *Samour*, *Donohue* and *Bristol-Myers*.

The Examiner's position is not inconsistent with either *In re LeGrice* or *Ex parte Thomson*. In *LeGrice*, the court held that in order for a printed publication to be a statutory bar under 35 USC 102(b), the publication must provide an enabling disclosure. In the words of the court,

"before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention.*" 133 USPQ at 372 (emphasis in original).

The court then states that plant publications should not be totally ignored as printed publications; rather the fact that a printed publication must be enabling "requires that the facts of each case be carefully considered to determine whether the description in a the printed publication in question *does in fact* place the invention in the possession of the public" 133 USPQ at 374.

In summarizing the long recognized requirements of a prior publication, the court quotes Robinson on Patents, Sec. 325 as follows:

[To have the effect of a prior publication.] the publication must be: (1) A work of public character, intended for general use; (2) Within reach of the public; (3) Published before the date of the later invention; (4) A description of the same complete and operative art or instrument; and (5) So precise and so particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. Unless a publication possesses all these characteristics it does not place the invention in the possession of the public. 133 USPQ at 369.

The PBR document that is relied upon by the Examiner is a publication that meets each of these criteria. The application and granting of Plant Breeders' Rights is carried out in a public forum and can be easily accessed through the Internet, CD-ROM, and Official Gazette in the European Community. The cited PBR document was made public more than one year prior to filing in the United States. The citation is drawn to the same plant for which patent was filed. Lastly, the PBR document precisely refers to the species of plant and the name of the plant. Since this plant was sold more than one year prior to the effective filing date of the present application, one skilled in the art would have been able to purchase and propagate the plant "without experiments or further inventive skill". One of even ordinary skill in the art would have been able to reproduce the plant asexually and grow it without experimentation. Therefore, it is believed that the PBR document is an enabling publication.

(information included on the referenced publication) and subsequently obtain a plant since it was being marketed by Appellant's own admission. Such a plant would thus have been in the public possession due to information in the publication.

It is generally recognized that *prior public use and sale of a plant are the avenues by which a plant enters the public domain.* See, e.g., *LeGrice*, 133 USPQ at 370-71. The Examiner agrees with Appellant that the PBR publication by itself would not be an enabled publication, were the plant not in the public domain. However, the PBR publication when considered in combination with the knowledge of one skilled in the art, i.e., the availability of the plant in the public domain as evidenced by sale of the claimed plant more than one year prior to application for patent, places the plant in the public domain, and therefore is enabled since one skilled in the art would have been able to reproduce that exact same plant through asexual means. *LeGrice* ruled that a publication alone was not enough to put a plant in the public domain. The fact scenario of this rejection does not parallel the facts in the *LeGrice* case because the rejection here is not based on a publication alone. Indeed, *LeGrice* makes it very clear that "Prior public use and sale of a plant are the avenues by which a plant enters the public domain." The PBR publication, together with public availability of the plant, would have allowed a skilled artisan to take the teachings of the cited PBR and combine them with his own knowledge of the art to be in possession of the invention.

Dr. Richard Craig's declaration has been reviewed. The Examiner agrees with Dr. Craig that it is practically impossible to generate the claimed plant from a description thereof in a printed publication, since it is a product of a cross-fertilization of heterozygous parents. However, the rejection is not based on one of skill in the art being able to reproduce a particular plant from a description or a drawing. The rejection is based on the fact that a skilled artisan could take the teachings of the cited PBR document and *in combination with his or her own knowledge of the particular art be in possession of the invention* due to the fact that the claimed plant was sold more than one year prior to the filing date of the U.S. application. As explained above, the publication in light of the fact that the claimed plant was sold, put the plant in the public domain more than one year prior to the U.S. filing.

Additionally, the Craig declaration does **not** show that the *Thomson* Board was incorrect in concluding that one could buy seeds and obtain the claimed plant. The Examiner is not suggesting that the claimed plant can be obtained from the PBR description. Neither did the *Thomson* Board suggest that the plant could be obtained solely from the publication. In both the instant rejection as well as in the *Thomson* case, the public availability is recited as "enabling" the publications. In other words, the teachings of the publications in combination with the knowledge of one of ordinary skill in the art put the invention in the public domain. The Craig declaration does not refute that one of ordinary skill in the art would have been able to reproduce the exact same plant as cited in the PBR document and as claimed in the application for U.S. patent given the fact that the plant was available to the public more than one year prior to filing.

The Examiner fails to see the validity of the argument presented on page 12 of the Appeal Brief that § 163 does not grant a right to exclude others from "making" a claimed plant but only excludes others from asexually reproducing or selling the claimed plant. In the case of asexually propagated plants, the plant is "made" by asexually propagating plants. This is acknowledged in 35 U.S.C. 112, first paragraph, wherein the "specification shall contain a written description of the invention, and of the manner and process of making..." In the case of plant Patents, the invention is not considered reduced to practice until it has been asexually reproduced and wherein the progeny have the exact same characteristics as the parent. The *LeGrice* Court reversed the Board and the Examiner precisely because the cited references did not adequately teach how to make the claimed invention. Therefore, anticipatory prior art must meet the same requirements in plant patents as it does in utility patents. Furthermore, an additional reference used to show that the primary reference put the plant in possession of the public is perfectly appropriate to use in a plant patent application.

**Appellant argues** that the *LeGrice* decision was based on evidence of sale of the claimed plant in England (brief, pp. 13-14). This assertion is incorrect and not persuasive. The *LeGrice* decision states, "The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record..." 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere.

Display of a plant at an exhibition does no more to put the plant in possession of the public than would a publication standing alone. The fact that Mr. LeGrice was named as "distributor" does not indicate that the plants had, in fact, been distributed. The date and circumstances of any distribution must also be known to evaluate whether it amounts to public availability more than a year before filing for a

placed his invention in the public domain, file his application within one year thereafter..." (133 USPQ 365, 371). Clearly, the Court did not believe that the claimed plant was in the public domain.

Applicant LeGrice never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Brief, attachment p. 22). It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection (Brief, attachment p. 22, last paragraph).

The question of "publication plus sale" was not before the Court; only the question of "publication alone" was before them. Therefore, the *LeGrice* Court was not reviewing (or implicitly agreeing with) any statements by the Board of Appeals regarding public use or sale, but rather was reviewing the Board's decision, which, explicitly, did not involve public use or sale enablement issues. The Board of Appeals in *Ex parte Thomson* also concluded that the *LeGrice* Court did not have facts in evidence showing commercial availability of the claimed plants (24 USPQ2d 1618, 1621).

**Appellant argues** (page 15 of Appeal Brief) that implicit in *LeGrice* is that a publication describing a plant and a source to obtain that plant is not prior art to a plant patent application on that plant. However, this issue was not before the Court in *LeGrice*. There is no discussion in *LeGrice* about enablement of the printed publication on the claimed geranium plant based on any other source, such as public availability of the plant. In fact, in *Ex parte Thomson*, page 1621, the Board recognized "...that there is no indication that *LeGrice* had in evidence the facts supporting commercial availability..."

As stated previously, the issue before *LeGrice* was whether a publication needed to be enabling to be considered prior art in a plant case, and as stated previously, the Court decided that the publication presented to them was not enough to put the invention in the public domain. However, public use and sale of a plant does put it in the public domain. The question decided in *LeGrice* was, "Do publications have to be enabled to be considered as prior art under 35 USC 102 for plant patents?" The answer was a resounding "Yes!" However, as noted previously, there was no evidence of public availability of the plant described in the reference publication in *LeGrice*, and therefore that issue was not before the court or addressed by the court in its decision.

**Appellant argues** (page 15 of Appeal Brief) that while public prior use and sale are avenues by which a plant enters the public domain, that prior use or sale must have occurred in the United States to rise to the level of a statutory bar. This argument is not necessarily far from the mark. The problem is,

publication, not prior use or sale. The question then becomes, is a publication teaching a particular plant enabled if the public has possession of the plant and has the knowledge to make and reproduce that plant?

In attempting to distinguish the present case from *Ex parte Thomson*, **Appellant argues** (page 16 of Appeal Brief) the cited publication contained substantially the same description as the specification and that the publication as well as the specification was enabled by the availability of the claimed seeds.

The Examiner fails to see the distinction between the public availability in *Thomson* as enabling a publication versus the public availability enabling the cited PBR in the present case. There is no dispute in the instant case that the claimed plant and the plant cited in the PBR are the same plant. On the contrary, Appellant has previously admitted that they are the same plant. No amount of descriptive words, change the fact that the publication, sale, and specification are all drawn to the exact same plant.

Appellant points out that *Thomson* is directed to a utility application whereas the present application is directed to a plant patent. **Appellant argues** (page 17 of Appeal Brief) that a utility claim has a broader scope and the standard for anticipation by a printed publication is to be more broadly applied to the claims in a utility application than to the claim in a plant patent. **Appellant further argues** the claims must be fully enabled whereas there is no such enablement requirement of a plant patent claim.

*In re LeGrice* as well as 35 USC 161 and 37 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to patents for plants except for the one exception set forth in 35 USC 162. As a result, the standard for anticipation in a plant patent is the same as the standard for anticipation in a utility patent.

**Appellant argues** (page 18 of Appeal Brief) that every material element of the *Thomson* claim was set forth in the primary reference and that the additional reference was cited solely to show that the plant material was in the public domain. As such, the combining of a PBR application with public availability of a plant under 35 U.S.C. 102(b) is improper in a plant application. **Appellant further argues** that every material element of the claimed subject matter does not exist in the primary reference of the PBR application, and that the instant plant could not be reproduced from the reference. **Appellant argues** that this contrasts with *Samour*, *Donohue*, and *Thomson* because the descriptive words of the specification before the Board did not differ substantially from the disclosures of the cited publications. The argument concludes that there is a large difference between the instant specification and the cited PBR documents because the two differ substantially from each other in contrast to the specification and publication discussed in *Ex parte Thomson*. As a result, even if one were somehow capable of

This argument has already been discussed above, however, the Examiner would like to additionally point out that in *Ex parte Thomson*, the Board did not state that a full disclosure of the plant was required in the publication. Mere fact of the full disclosure was made to address the question as to whether the references were indeed drawn to the same plant. The *Thomson* decision states, "...we concur with the examiner that the claimed subject matter was described in a printed publication under circumstances whereby it was in the possession of the public more than one year prior to the filing date of the present application." 24 USPQ2d at 1620. The Board further states, "Manifestly, it is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokra seeds readily available on the open market." *Id.*

The completeness of the description was not an issue in the *Thomson* case. Rather, it was used to document that there was no disagreement as to whether the claimed plant was a different plant from the plant cited in the reference. The instant case is similar in that there is no disagreement that the PBR publications reference the claimed plant. The fact that the referenced plant is the same as the claimed plant automatically confers that every material element of the claimed subject matter existed in the reference because those characteristics not specifically disclosed are inherent. The issue decided in *Ex parte Thomson* was that if deposit (availability) of the plant enabled the specification, then availability also enabled the publications. It is the availability of the plant cited in *Thomson* that is important, not the description of the plant. In this case, there is no dispute that the PBR publication references the same plant.<sup>2</sup> Additionally, the availability of the claimed geranium plant enables the cited PBR publications. Based solely on the reference, a skilled artisan would have been able to buy a geranium plant named 'Tikvio' which would have been the exact same geranium plant as described in the application for patent. The Examiner readily admits that the plant cannot be reproduced from the reference except for the fact that sale of the invention put the invention in the public domain. The Examiner agrees that the PBR publication does not meet the "as complete as is reasonably possible" standards of a US application, but it does contain the **material elements** necessary to put the invention in the public domain in light of the fact that the plant was available to the public. Appellant has not pointed out how the admission that the instant plant has been sold makes up for any particular "deficiency" in the cited publication. The rejection is not combining references using motivation, nor is it improperly combining "on sale in the United States" with a publication, rather the sale of the plant is used to show that the publication was "enabled" and that the plant was in possession of the public under 35 U.S.C. 102(b) in keeping with *In re Samour*, *In re Donohue*, *In re LeGrice*, and *Ex parte Thomson*.

A § 102(b) printed publication can be published and enabled anywhere in the world. It does not matter that the plant is available only outside the United States more than one year before the U.S. filing date. The enablement need not occur in the United States.

**Appellant argues** that the PBR is an incomplete document, but the Craig declaration says that no amount of description would have been enabling. The plant material must be available for the public to have possession. Appellant admits that the plant material was available. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden then shifts to the Appellant to show an

unobvious difference (see MPEP 2112). As a result, the Appellant needs to prove that the prior art products do not necessarily or inherently possess the characteristics of the claimed product.

Penultimately, **Appellant argues** (page 21 of Appeal Brief) that enablement of a PBR publication as a prior art reference is inconsistent with past and current examination practices. **Appellant further argues** that "USPTO cannot have it both ways of asserting a PBR application as enabling prior art and rejecting reasonably detailed plant patent applications for lack of enablement."

A PBR application is enabled as prior art if it sufficiently describes the claimed invention to have placed the public in possession of it. That this is the case in this instance has been argued extensively above. In response to the second part of the argument, the Examiner would like to point out that the Office does not reject plant patent applications for lack of enablement. In fact, it is recognized that the mere description of a plant no matter how detailed it might be does not constitute an enabling description because it does not put the public in possession of the plant. However, if the description in a plant patent application is inadequate, the Examiner rejects the claim under 35 U.S.C. 112, first paragraph, as follows:

"Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above."

The claim is rejected on the basis of inadequate description, not "enablement" or "how to make and use". 35 U.S.C. 112, first paragraph requires written description of the invention **and** of the manner and process of making and using it. Although Applicants in plant patent applications are relieved of the enablement requirement, they are not relieved of the written description requirement. A better description does not enable a specification, only a deposit or public availability enables a specification.

Finally, **Appellant argues** (page 23 of Appeal Brief) that the current rejection policy is a detriment to the public because plants available in other countries may be withheld from the U.S. market. After careful consideration of this argument, the Examiner declines to comment on this business practice as the issue is not germane to the current rejection.

### **Conclusion:**

Appellant concludes, "The only § 102(b) bar to plant patent applications is the sale, offer for sale, or public use of the plant itself within the United States....It follows that the plant itself must be present in

statute or case law. Except for the different treatment accorded plant patent applications under § 112, the same statutes and regulations apply to both plant and utility patent applications. The *LeGrice* Court noted that "...only an 'enabling' publication is effective as a bar to a subsequent patent. We do not agree with the view expressed by the examiner that this necessarily requires that plant publications be 'totally ignored.'" 133 USPQ at 374. Appellant's position appears to be that all printed publications are, by definition, non-enabling in the plant art and therefore no rejection can ever be made over a printed publication. This is contrary to what the *LeGrice* Court stated in their decision.

For the above reasons, it is believed that the rejections should be sustained.

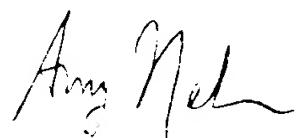
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June 23, 2003

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